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**OFFICE OF PETITIONS**

In re Application of :  
Gillespie et al. : DECISION ON APPLICATION  
Application No. 09/642,203 : FOR  
Filed: August 19, 2000 : PATENT TERM ADJUSTMENT  
Attorney Docket No. 1752/USW1752PUS:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed April 18, 2005. Applicants request that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be corrected from three hundred two (302) days to four hundred eighty-four (484) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is five hundred eighty-five (585) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 24, 2005, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised that the patent term adjustment to date is 302 days. In response, applicants timely<sup>1</sup> filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 C.F.R. § 1.18(e). Applicants request that the patent term adjustment

<sup>1</sup> PALM Records indicate that the Issue Fee payment was not received until June 9, 2005.

be corrected to 484 days. Applicants dispute the reduction of 182 days for applicant delay. In essence, applicants assert that their response filed April 15, 2004, was filed within three months of the mail date of the Notice restarting the period for reply mailed January 16, 2004. Thus, there was no delay within the meaning of § 1.704(b).

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The application history has been reviewed and it has been determined that the initial patent term adjustment of 302 days is incorrect. The Office mailed an Office action under section 132 on July 16, 2003, within four months of the date of filing of applicant's reply, June 2, 2003 (not May 28, 2003, as discussed below). However, the Notice was not mailed to the correspondence address of record. The record supports a conclusion that this was due to an error on the part of the Office in mailing the Office action to applicants. Accordingly, a letter restarting the period for reply (and re-mailing the notice) was mailed on January 16, 2004. Under the circumstances, applicants are correct that they did not fail to engage in reasonable efforts within the meaning of § 1.704(b). Their response filed April 15, 2004, was received within three months of the mailing of the Office action as re-mailed on January 16, 2004. Accordingly, a period of reduction of 182 days should not have been entered.

Moreover, given the date of re-mailing of the Office action, there is a further basis for entry of a period of adjustment for Office delay. Using the mail date of January 16, 2004, it is concluded that the Office took in excess of four months to respond to applicants' reply filed June 2, 2003. Pursuant to § 1.703(a)(2), the period of adjustment is the number of days in the period of delay beginning on October 3, 2003, the day after the date that is four months after the date a reply under § 1.111 was filed, to January 16, 2004, the date of mailing of the Office action is 106 days.

However, a review of the record further reveals a basis for entry of another period of reduction. As alluded to, applicants' response after non-final Office action mailed February 28, 2003, was received in the Office on June 2, 2003, not May 28, 2003 (the certificate of mailing date). In this regard, applicants' attention is directed to 37 CFR 1.703(f),

which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Thus, applicants took in excess of three months to respond to the Office action. Accordingly, pursuant to § 1.704(b), a period of reduction of 5 days should have been entered for applicant delay from May 29, 2003 to June 2, 2003.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is 585 days ((106 + 497) - (5 + 13)).

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

The application is being forwarded to Technology Center 2683 for consideration of the amendment under § 1.312 filed June 9, 2005.

Telephone inquiries regarding this matter should be directed to Senior Petitions Attorney Nancy Johnson at (571) 272-3219.

*Karin A. Ferriter*  
*for*

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Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Enclosure: Copy of updated PAIR screen